



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,784	06/19/2000	James Crawford	06975-097001	4992

26171 7590 06/26/2006
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

SHINGLES, KRISTIE D

ART UNIT	PAPER NUMBER
----------	--------------

2141

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/597,784

Applicant(s)

CRAWFORD, JAMES

Examiner

Kristie Shingles

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 and 45-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 and 45-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

*Claims 1, 14, 29-40, 45 and 61 have been amended. Claims 41-44 have been cancelled.
Claims 71-78 are new.*

Claims 1-40 and 45-78 are pending.

Response to Arguments

1. Applicant's arguments with respect to claims 1, 14, 29-31, 36 and 45 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-40 and 45-78** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Donovan* (US 2004/0193722) in view of *van Hoff et al* (US 5,761,421) and *Miyake et al* (US 6,678,341).

a. **Per claims 1, 29, and 31**, *Donovan* teaches a method, apparatus, and computer program, stored on a computer readable medium for transferring a file from a first client associated with a first subscriber to a communications system to a second client associated with a second subscriber to the communications system, the method comprising:

- connecting the first client to a communications system host (paragraphs 0019-0025);
- establishing an instant messaging communications sessions with the second client to enable instant messaging communications to be exchanged between the first client and the second client over a first communications channel, the first communications channel passing through the communications system host (paragraphs 0033-0036),
- if a user of the second client accepts the request, establishing, a direct connection to the second client that bypasses the communications system host (paragraphs 0034-0036; user of the second client accepts the request and a direct connection is subsequently established between the first and second client); and
- transferring a file over the second communications channel (paragraph 0037).

Although *Donovan* does teach a first client sending a connection request to the second client via the instant messaging system (paragraph 0034); *Donovan* fails to explicitly state that after establishing the instant messaging communications session, sending, through the communications system host, a request to the second client to establish a direct connection to the second client and in the instant messaging communications session, a second communications channel between the first client and the second client to enable files to be directly transferred between the first client and the second client, wherein the second communications channel consists of a direct connection to the second client that bypasses the communications system host. However, *van Hoff et al* teach a first computer requesting peer-to-peer communication connection with the second client, wherein the second client is able to accept or reject the request (col.1 lines 55-67). Furthermore, *Miyake et al* teach that clients are capable of establishing two distinct communication channels: a two-way communication channel between the two clients through the basestation and a peer-to-peer direct communication bypassing the basestation and

Art Unit: 2141

communicating over the direct connection (col.5 line 61-col.6 line 10, col.7 line 39-col.8 line 13, col.9 line 59-col.10 line 12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Donovan* with *van Hoff et al* for the purpose of allowing clients to specifically request peer-to-peer or direct connections with other clients. Peer-to-peer connections cause the client devices to be more vulnerable without an intermediary host or server to relay the transmitted data, therefore it would be obvious to allow users to determine and discern between whom has direct connectivity with their devices. Furthermore, it would've been obvious to combine *Donovan* and *van Hoff et al* with *Miyake et al* for implementing two distinct channels for communication, utilizing a channel that bypasses the host/server/basestation system and a channel that provides two-communication through the host/server/basestation system, in order to provide faster communication times between the two client devices.

b. **Per claims 14, 30, and 36**, *Donovan* teaches a method, apparatus, and a computer program, stored on a computer readable medium for transferring a file from a first client associated with a first subscriber to a communications system to a second client associated with a second subscriber to the communications system, the method comprising:

- connecting the second client to a communications system host (paragraphs 0019-0025);
- establishing an instant messaging communications sessions with the second client to enable instant messaging communications to be exchanged between the first client and the second client over a first communications channel, the first communications channel passing through the communications system host (paragraphs 0033-0036),
- enable a user to accept the request from the first client (paragraphs 0034-0036; user of the second client accepts the request and a direct connection is subsequently established between the first and second client);

- establishing a direct connection to the first client that bypasses the communications system host (paragraphs 0036, 0037); and
- receiving a file over the second communications channel (paragraph 0037).

Although *Donovan* does teach a first client sending a connection request to the second client via the instant messaging system (paragraph 0034); *Donovan* fails to explicitly state that after establishing the instant messaging communications session, sending, through the communications system host, a request to the second client to establish a direct connection to the second client and in the instant messaging communications session, a second communications channel between the first client and the second client to enable files to be directly transferred between the first client and the second client, wherein the second communications channel consists of a direct connection to the second client that bypasses the communications system host. However, *van Hoff et al* teach a first computer requesting peer-to-peer communication connection with the second client, wherein the second client is able to accept or reject the request (col.1 lines 55-67). Furthermore, *Miyake et al* teach that clients are capable of establishing two distinct communication channels: a two-way communication channel between the two clients through the basestation and a peer-to-peer direct communication bypassing the basestation and communicating over the direct connection (col.5 line 61-col.6 line 10, col.7 line 39-col.8 line 13, col.9 line 59-col.10 line 12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Donovan* with *van Hoff et al* for the purpose of allowing clients to specifically request peer-to-peer or direct connections with other clients. Peer-to-peer connections cause the client devices to be more vulnerable without an intermediary host

Art Unit: 2141

or server to relay the transmitted data, therefore it would be obvious to allow users to determine and discern between whom has direct connectivity with their devices. Furthermore, it would've been obvious to combine *Donovan* and *van Hoff et al* with *Miyake et al* for implementing two distinct channels for communication, utilizing a channel that bypasses the host/server/basestation system and a channel that provides two-communication through the host/server/basestation system, in order to provide faster communication times between the two client devices.

c. **Per claim 45**, *Donovan* teaches a user interface configured to enable to acceptance or rejection of a file transfer from a first client associated with a first subscriber to a communications system to a second client associated with a second subscriber to the communications system, the user interface comprising:

- a first graphical user interface element structured and arranged to notify an operator of the second client of a request by the first client to establish a direct connection to the second client, the request being communicated to the second client by a communications system host and the direct connection bypassing the communications system host (paragraphs 0033-0036); and
- a second graphical user interface element structured and arranged to enable an operator of the second client to authorize the establishment of the direct connection and a file transfer over the direct connection (paragraphs 0034-0037).

Although *Donovan* does teach establishing an instant messaging session and a first client sending a connection request to the second client via the instant messaging system (paragraph 0034); *Donovan* fails to explicitly state that the request is to establish direct connection to the second client and after establishment of an instant messaging communications session with the first client and the direct communication bypassing the communications system host, the instant messaging communications session enabling instant messaging communications to be exchanged between the first client and the second client over a first communications

Art Unit: 2141

channel that passes through the communications system host. However, *van Hoff et al* teach a first computer requesting peer-to-peer communication connection with the second computer, wherein the second computer is able to accept or reject the request (col.1 lines 55-67). Furthermore, *Miyake et al* teach that clients are capable of establishing two distinct communication channels: a two-way communication channel between the two clients through the basestation and a peer-to-peer direct communication bypassing the basestation and communicating over the direct connection (col.5 line 61-col.6 line 10, col.7 line 39-col.8 line 13, col.9 line 59-col.10 line 12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Donovan* with *van Hoff et al* for the purpose of allowing clients to specifically request peer-to-peer or direct connections with other clients. Peer-to-peer connections cause the client devices to be more vulnerable without an intermediary host or server to relay the transmitted data, therefore it would be obvious to allow users to determine and discern between whom has direct connectivity with their devices. Furthermore, it would've been obvious to combine *Donovan* and *van Hoff et al* with *Miyake et al* for implementing two distinct channels for communication, utilizing a channel that bypasses the host/server/basestation system and a channel that provides two-communication through the host/server/basestation system, in order to provide faster communication times between the two client devices.

d. **Per claim 2**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the request is authenticated by the communications system host (paragraphs 0033, 0038, 0039).

e. **Per claims 3 and 16**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the second client accepts the request based on indicated preferences of the second subscriber (paragraph 0035).

f. **Per claims 4 and 17**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the direct connection is initiated by the second client (paragraphs 0034-0036).

g. **Per claims 5 and 18**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the direct connection to the second client is established using an IP address of the second client (paragraphs 0020, 0034).

h. **Per claims 6 and 19**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1 and 14, *Donovan* further teaches further comprising displaying a graphical user interface indicating that a direct connection to the second client is established (paragraphs 0034, 0037).

i. **Per claims 7 and 20**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the communications system host comprises an instant messaging host (paragraphs 0009, 0026, 0027, 0033, 0036).

j. **Per claims 8 and 21**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the file comprises a data file (paragraphs 0019, 0037).

k. **Per claims 9 and 22**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the file comprises a text file (paragraphs 0019, 0037).

l. **Per claims 10 and 23**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the file comprises a graphics file (paragraph 0037).

m. **Per claims 11 and 24**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the file comprises an audio file (paragraphs 0019, 0037).

n. **Per claims 12 and 25**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1 and 14, *Donovan* further teaches wherein the file comprises a video file (paragraph 0037).

o. **Per claims 13 and 28**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1 and 14, *van Hoff et al* further teach wherein the direct connection is a socket connection (col.2 lines 49-65; *Donovan*: paragraphs 0036, 0037; *Miyake et al*: col.7 lines 39-67).

p. **Per claim 26**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 14, *Donovan* further teaches the method further comprising receiving an indication that the first subscriber using the first client is composing a message (paragraphs 0041-0044).

q. **Per claim 27**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 26, *Donovan* further teaches the method further comprising receiving the message composed by the first subscriber from the first client (paragraphs 0041-0044).

r. **Per claims 32 and 37**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 31 and 36, *Donovan* further teaches wherein the computer readable medium comprises a disc (paragraphs 0009, 0018).

s. **Per claims 33 and 38**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 31 and 36, *Donovan* further teaches wherein the computer readable medium comprises a client device (paragraphs 0009, 0018; *Miyake et al*: col.7 lines 39-67).

t. **Per claims 34 and 39**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 31 and 36, *Donovan* further teaches wherein the computer readable medium comprises a host device (paragraphs 0036, 0037).

u. **Per claims 35 and 40**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 31 and 36, *Donovan* further teaches wherein the computer readable medium comprises a propagated signal (paragraphs 0009, 0018, 0019).

v. **Per claim 46**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the user interface of claim 45, *Donovan* further teaches wherein the first graphical user interface element is a dialog box (paragraph 0034).

w. **Per claim 47**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the user interface of claim 45, *Donovan* further teaches wherein the second graphical user interface element includes a set of sub elements selectable by the recipient to authorize or reject establishment of the direct connection (paragraphs 0034, 0035).

x. **Per claim 48**, *Donovan* teaches the user interface of claim 47 wherein the sub elements are option buttons (paragraph 0034).

y. **Per claim 49**, *Donovan* teaches the user interface of claim 47 wherein the sub elements include a sub element selectable to authorize the direct connection (paragraphs 0034, 0035).

Art Unit: 2141

z. **Per claim 50**, *Donovan* teaches the user interface of claim 47 wherein the sub elements include a sub element selectable to reject the direct connection (paragraph 0034).

aa. **Per claim 51**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the user interface of claim 47, *van Hoff et al* further teach wherein the sub elements include a sub element selectable to ignore the request (col.4 lines 18-21).

bb. **Per claim 52**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the user interface of claim 47, *van Hoff et al* further teach wherein the sub elements include a sub element selectable to warn the first client not to send future requests for a direct connection to the second client (col.4 lines 18-21).

cc. **Per claims 53, 55, and 57**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1, 29, and 31, *Donovan* further teaches wherein connecting the first client to a communication system host includes connecting from the first client to the communication system host (paragraphs 0019-0025; *Miyake et al*: col.7 lines 11-66).

dd. **Per claims 54, 56, and 58**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 14, 30, and 36, *Donovan* further teaches wherein connecting the second client to a communications system host includes connecting from the second client to the communications system host (paragraphs 0019-0025; *Miyake et al*: col.7 lines 11-66).

ee. **Per claims 59-64**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1, 14, 29, 30, 31, and 36, *Donovan* further teaches the method further comprising enabling the user to perceive the request and monitoring a response by the user to the request (paragraphs 0034, 0035).

ff. **Per claims 65-70**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claims 59-64, *Donovan* further teaches the method further comprising enabling the request to be visually presented in a graphical user interface to the user of the second client (paragraphs 0034, 0035).

gg. **Per claims 71-74**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1, 14, 31 and 36, *Donovan* further teach sending an instant message to the second client through the first communications channel during the instant messaging communications session (paragraph 0037; *Miyake et al*: col.5 line 60-col.6 line 10, col.9 line 59-col.10 line 12).

hh. **Per claims 75-78**, *Donovan* and *van Hoff et al* with *Miyake et al* teach the method of claim 1, 14, 31 and 36, *Donovan* further teach wherein the user of the second client manually accepts the request (paragraph 0035; *Miyake et al*: col.10 lines 50-64).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Riddle (5,857,189).

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 2141

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

kds


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER